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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,376	08/02/2001	Masahiko Sato	450100-03439	4275

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NEW YORK, NY 10151

EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,376

Applicant(s)

SATO ET AL.

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15, 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-7,9-15, and 17 have been considered.

Claim Rejections - 35 USC § 112

5 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10

Claims 3,6,11, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claims 3 and 11, the claims disclose that the transmission output is **only** reduced in a particular one of said radio devices. Independent claims 1 and 9 have been amended to disclose that the coverage area of **both** portable devices is reduced. Thus claims 3 and 11 are logically inconsistent with amended claims 1 and 9. Claims 6 and 14 are rejected based on similar reasoning.

20

Claims 1-7,9-15, and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner does not find the following limitation in the disclosure: "specifying other devices to be mutually authenticated when the two or more portable radio devices are within a predetermined range of each other over said second coverage area". Appropriate correction or a specific reference to where this limitation is disclosed is required.

30

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5 Claims 1-7,9-15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1,9, and 17, recite the limitation "preventing communication with an unintentional portable radio device by narrowing the coverage area of both portable devices to be mutually authenticated before authentication initiates". It is unclear whether the phrase "before authentication
10 initiates" refers to narrowing the coverage area or the mutual authentication.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
20

 Claims 1-7,9-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nealon, U.S. Patent No. 5,463,659, in view of Cotton, U.S. Patent No. 6,148,205, in further view of Executive Council (Executive Council. Fourteenth Session. 2-5 February 1999. pages 1,22).

25 As per claims 1,9, and 17, the applicant describes an authenticating method for portable radio devices, comprising data communicating means for performing radio communication over a first coverage area and authorizing means for performing authentication of said portable radio device over a second coverage area, comprising the following limitations which are met by Nealon, Cotton, and Executive
30 Council:

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a) switching coverage area of two or more of said portable radio devices to be mutually authenticated from the first coverage area to the second coverage area, the second coverage area being smaller than the first coverage area (Nealon: Col 8, lines 23-34; Executive Council: page 22);

5 b) the two or more portable radio devices to be mutually authenticated having the second coverage area being brought within proximity of one another so that the coverage areas overlap (Nealon: Col 8, lines 23-34);

c) performing mutual authentication between two or more portable radio devices by said authenticating means automatically when the coverage area of the two or more portable radio devices overlap (Cotton: Col 5, lines 25-31; Nealon: Col 9, lines 3-25);

10 d) preventing communication with an unintentional portable radio device by narrowing the coverage area of two or more portable radio devices to be mutually authenticated before authentication initiates based on the proximity of the two or more portable radio devices (Nealon: Col 8, lines 23-34);

e) specifying other devices to be mutually authenticated when the two or more portable radio devices are within a predetermined range of each other over said second coverage area (Nealon: Col 9, lines 3-25; Cotton: Col 5, lines 25-31);

15

Nealon discloses an authenticating method for two or more radio devices. Nealon teaches switching coverage area from a first coverage area to a second coverage area being smaller than the first coverage area (part a), the two or more portable radio devices to be authenticated having the second coverage area being brought within proximity of one another so that the coverage areas overlap (part b),

20 preventing communication with an unintentional portable radio device by narrowing the coverage area of the two or more portable radio devices to be authenticated before authentication initiates based on the proximity of the two or more portable radio devices (part d), and specifying other devices to be authenticated when the two or more portable radio devices are within a predetermined range of each other over said second coverage area (part e). However, Nealon does not teach "performing **mutual**

25 **authentication** between two or more portable radio devices by said authenticating means automatically when the coverage area of the two or more portable radio devices overlap" (part c).

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Cotton discloses a similar authentication system between radio devices. Cotton also discloses the idea of performing mutual authentication between the radio devices. Combining the ideas of Cotton with those of Nealon allows a mutual authentication process to take place. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Cotton with those of Nealon because incorporating mutual authentication makes a system more robust through authentication of both entities involved in the communication.

Nealon in view of Cotton disclose communication between a portable device and a base station. Both Nealon and Cotton, however, are silent as to whether the base station is portable. Executive Council discloses the idea that a radio base station may be portable. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Executive Council with those of Nealon in view of Cotton because having a portable base station allows the base station to be more versatile as it can be moved around the room to provide the most efficient communication between itself and the portable device(s).

As per claims 2 and 10, the applicant describes the authenticating method for the portable radio devices according to claims 1 and 9, which are met by Nealon in view of Cotton in further view of Executive Council, with the following limitation which is met by Nealon:

Wherein the step of performing the authentication by said authenticating means is performed in a state where a transmission output of said portable radio device is reduced to shorten a communication distance of said portable radio device (Nealon: Col 8, lines 23-34).

As per claims 3 and 11, the applicant describes the authenticating method of claims 2 and 10, which are met by Nealon in view of Cotton in further view of Executive Council, with the following limitation which is met by Nealon:

Wherein the transmission output is reduced only in a particular one of said portable radio devices (Nealon: Col 8, lines 23-34).

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As per claims 4 and 12, the applicant describes the authenticating method of claims 2 and 10, which are met by Nealon in view of Cotton in further view of Executive Council, with the following limitation which is met by Cotton:

Wherein the transmission output is reduced upon turning-on of an authentication button provided
5 on said particular one of said portable radio devices (Nealon: Col 8, lines 23-34).

As per claims 5 and 13, the applicant describes the authenticating method of claims 1 and 9, which are met by Nealon in view of Cotton in further view of Executive Council, with the following limitation which is met by Nealon:

10 Wherein the step of performing the authentication by said authenticating means is performed in a state where reception sensitivity of said radio device is reduced to shorten a communication distance of said radio devices (Nealon: Col 8, lines 23-34).

As per claims 6 and 14, the applicant describes the authenticating method of claims 5 and 13,
15 which are met by Nealon in view of Cotton in further view of Executive Council, with the following limitation which is met by Nealon:

Wherein the reception sensitivity is reduced only in a particular one of said portable radio devices (Nealon: Col 8, lines 23-34).

20 As per claims 7 and 15, the applicant describes the authenticating method of claims 5 and 13, which are met by Nealon in view of Cotton in further view of Executive Council, with the following limitation which is met by Cotton:

Wherein the reception sensitivity is reduced upon turning-on of an authentication button provided on said particular one of said portable radio devices (Nealon: Col 8, lines 23-34).

25

Response to Arguments

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Applicant's arguments filed 11/21/05 with respect to the 112 rejections of claims 3,6,11, and 14 have been fully considered but they are not persuasive. Applicant argues that the amendments have rectified the problems of the previous action. Examiner respectfully disagrees. To reiterate, claims 3 and 11 disclose that the transmission output is **only** reduced in a particular one of said radio devices.

5 Independent claims 1 and 9 disclose that the coverage area of **both** portable devices is reduced. Thus claims 3 and 11 are logically inconsistent with amended claims 1 and 9. Claims 6 and 14 are rejected based on similar reasoning. The claim amendments do not clear up the inconsistency.

Applicant's arguments with respect to the 112 rejections of claims 1-7,9-15, and 17 have been
10 fully considered but they are not persuasive. Applicant argues that the amendments have rectified the problems of the previous action. Examiner respectfully disagrees. To reiterate, claims 1,9, and 17 recite the limitation "preventing communication with an unintentional portable radio device by narrowing the coverage area of both portable devices to be mutually authenticated before authentication initiates". It is unclear whether the phrase "before authentication initiates" refers to narrowing the coverage area or the
15 mutual authentication. The claim amendments do not clear up the issue.

Applicant's arguments with respect to claims 1-7,9-15, and 17 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the
20 references. Applicant mentions teachings of Cotton, Nealon, and Executive Council. Applicant then submits that the three references do not meet the limitations of the claimed invention and restates limitations of the claims.

Examiner respectfully submits that such an argument is not in compliance with 37 CFR 1.111(b) for at least the reason that it does not specifically point out how the language of the claims patentably
25 distinguishes the claims from the references.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

5 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX
10 MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
15 Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through
20 Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

25 KS


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